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	APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
	09/778,045	02/07/2001	Takahisa Kurahashi	925-177	6211
	75	. 06/17/2002			
NIXON & VANDERHYE P.C.		ANDERHYE P.C.		EXAMINER	
	1100 North Gle Arlington, VA	e Road, 8th Floor 22201		CRANE, S	SARA W
				ART UNIT	PAPER NUMBER
				2811	
				DATE MAILED: 06/17/2002	

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)					
		09/778,045	KURAHASHI ET AL.					
	Office Action Summary	Examin r	Art Unit					
		Sara W. Crane	2811					
Period fo	Th MAILING DATE of this communication app or Reply	ears on the cover she twith the	correspond nce addr ss					
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). Status								
1)	Responsive to communication(s) filed on							
2a)□		— · is action is non-final.						
3)								
Disposition of Claims								
4) 🖂	Claim(s) $1-14$ is/are pending in the application							
	4a) Of the above claim(s) is/are withdrawn from consideration.							
5)	Claim(s) is/are allowed.							
6)	Claim(s) is/are rejected.							
7)	Claim(s) is/are objected to.							
8) Claim(s) <u>1-14</u> are subject to restriction and/or election requirement. Application Papers								
9)☐ The specification is objected to by the Examiner.								
10) 🔲 .	10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.							
	Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).							
11)☐ The proposed drawing correction filed on is: a)☐ approved b)☐ disapproved by the Examiner.								
If approved, corrected drawings are required in reply to this Office action.								
12)☐ The oath or declaration is objected to by the Examiner.								
Priority ι	ınder 35 U.S.C. §§ 119 and 120							
13)🖂	13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).							
a)	⊠ All b) ☐ Some * c) ☐ None of:							
	1. Certified copies of the priority documents	s have been received.						
	2. Certified copies of the priority documents	s have been received in Applicat	ion No					
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 								
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).								
a) ☐ The translation of the foreign language provisional application has been received. 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.								
Attachmen	t(s)							
2) Notic	e of References Cited (PTO-892) e of Draftsperson's Patent Drawing Review (PTO-948) mation Disclosure Statement(s) (PTO-1449) Paper No(s)	5) Notice of Informal	y (PTO-413) Paper No(s) Patent Application (PTO-152)					
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DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, drawn to a semiconductor device, classified in class 257, subclass 98.
- II. Claims 9-14, drawn to a method of making a semiconductor device,classified in class 438, subclass 689.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, unpatentability of the Group I invention would not necessarily imply unpatentability of the Group II invention, because the device of the Group I invention could be made by process(es) materially different from those/that of the Group II invention. For example, the device of claim 1 could be made by a method including the step of roughening a top surface of a semiconductor layer, rather than the step of roughening a wafer surface, as recited in claim 9.

Because these inventions are distinct for the reasons given above and, as shown by their different classifications, the fields of search are not co-extensive and separate examination would be required, restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is reminded of the notice published in the Official Gazette on March 26, 1996, "Guidance on Treatment of Product and Process Claims in Light of In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b)." If, in response to a requirement for election between a product and a process of making, Applicant elects claims directed to the product, and the product is subsequently found allowable, withdrawn process claims which depend from, or otherwise include all the limitations of, the allowable product will be rejoined. Those process claims which do not depend from, or otherwise include all the limitations of, the allowable product will not be rejoined. Rejoined process claims will be fully examined for patentability under 37 CFR § 1.104 to 1.106. Process claims which depend from, or otherwise include all the limitations of, a patentable product claim will be entered as a matter of right if the amendment is presented prior to final rejection. Rejoinder does not constitute a withdrawal of the requirement for restriction. Rejoinder is a new procedure first authorized by the OG notice.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Crane, whose telephone number is (703) 308-4894.

The fax phone number for this Group is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 308-0956.

Sara W. Crane Primary Examiner

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